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1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON TX 77002

In re Application of
Danielsson, et al.
Application No.: 09/683,769
Filing Date: 12 February, 2002
Attorney Docket No. 6730.008.NPUS01

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DECISION

This is a decision on the petitions filed on 10 October, 2007, to revive the instant application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

For the reasons set forth below the petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

NOTE: any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 20 October, 2003, with reply due absent an extension of time on or before 20 January, 2004;
- the application went abandoned after midnight 20 January, 2004;

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- the Office mailed the Notice of Abandonment on 23 July, 2004;
- on 21 December, 2005, more than twenty-three (23) months after abandonment and nearly seventeen (17) months after notice thereof, Petitioner filed via FAX (apparently under 37 C.F.R. §1.181) copies of a receipt card and claims, with no discussion of the facts and no explanation for the extended delays—Petitioner appears to have ignored the requirements set forth at 37 C.F.R. §1.181 and MPEP §711.03(c) regarding matters such as this for the filing of a petition within two months of the act complained of—a call was placed on 9 June, 2006, to Petitioner's offices to inquire about the matter, however, upon reaching the telephone number on the papers submitted by Petitioner in December 2005, the persons answering the call indicated that Petitioner had not been with the office for more than a year. Thus, it was not possible to inquire of the matter with Petitioner, and the petition under 37 C.F.R. §1.181 was dismissed on 12 June, 2006 (and Petitioner was given two months to reply);
- on 10 October, 2007, Petitioner filed the instant petition (under 37 C.F.R. §1.137(b) with fee, another copy of a receipt card and of an amendment and claims, set forth the regulatory statement of unintentional delay, but provided absolutely no explanation of the delay between the original due date of the reply to the non-final Office action mailed on 20 January, 2004, and the filing of papers that the Office generously constructed as a petition on 21 December, 2005; or of the delay between the decision mailed on 12 June, 2006, and the filing of the petition under 37 C.F.R. §1.137(b) sixteen months later on 10 October, 2007.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)); and those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

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STATUTES, REGULATIONS AND ANALYSIS

In General

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).²

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.³

Delays in responding properly raise the question whether delays are unavoidable.⁴ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁵

And the Petitioner must be diligent in attending to the matter.⁶ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁷))

As to Extended Delay

There are three periods to be considered during the evaluation of a petition under 37 C.F.R. §1.137(b):

² 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

³ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁴ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁵ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁶ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁷ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

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- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition to return the application to pending status; and
- (3) the delay in filing a grantable petition pursuant to 37 C.F.R. §1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1), and (2).

As to Period (1):

The patent statute at 35 U.S.C. §41(a)(7) authorizes the Director to revive an “unintentionally abandoned application.”

The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. §41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that: “[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable.”⁸

35 U.S.C. §41(a)(7) authorizes the Director to accept a petition “for the revival of an unintentionally abandoned application for a patent.” As amended December 1, 1997, 37 C.F.R. §1.137(b)(§3) provides that a petition under 37 C.F.R. §1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that “[t]he Commissioner may require additional information where there is a question whether the delay was unintentional.”

Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. §41(a)(7) and 37 C.F.R. §1.137(b).⁹ Here, in view of the inordinate delay seeking to resume prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

⁸ See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71.

⁹ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

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The question under 37 C.F.R. §1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment.

That party, in turn must explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction).

Likewise, then-Counsel of Record at the time of abandonment, must explain why this application became abandoned while it was under their control and what efforts were made to further reply of itself and with whom this matter was discussed.

Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), and whoever else was involved with this application at the time of abandonment.

Statements are required from any and all persons then the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action.¹⁰

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as “unintentional” within the meaning of 37 C.F.R. §1.137(b).¹¹ The language of both 35 U.S.C. §41(a)(7) and 37 C.F.R. §1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, “unintentional” for the reply to now be accepted on petition.

The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public.¹² The December 1997 change

¹⁰ See: Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

¹¹ See: MPEP 711.03(c).

¹² See: H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.A.N. 771 (“[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment”).

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to 37 C.F.R. §1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application¹³. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay.¹⁴

Statements are required from any and all persons then the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP §711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

(A) the date that the applicant first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 C.F.R. §1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.¹⁵

As to Allegations of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a proper reply, a statement/showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

As indicated above, Petitioner has failed to satisfy the statement/showing requirement under the regulation. Petitioner should address this matter in light of the guidance provided in the Commentary at MPEP §711.03(c)(II)(C) and (C)(1), and must provide documentary support including but not limited to "correspondence relative to the period of delay" and other showings as discussed above.

¹³ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over years) could trigger, as here, a request for additional information.

¹⁴ See: Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23.

¹⁵ See: New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S. District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

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CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **dismissed**.

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By Hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By FAX: Centralized Facsimile Number
 (571) 273-8300

By EFS: Correspondence regarding this decision may also be filed through the
 electronic filing system (EFS) of the USPTO.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2¹⁶) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



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Office of Petitions

¹⁶ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.